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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/183,732	10/30/1998	CHRISTOPHER D. WILLIAMS	042390.P6485	3453

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EXAMINER

MILLER, JOHN W

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 11/27/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

T.R

# Office Action Summary

Application No.  
09/183,732

Applicant(s)  
Williams et al

Examiner  
John W. Miller

Art Unit  
2611



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Aug 30, 2001

2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-32 is/are pending in the application

4a) Of the above, claim(s) 21-27 is/are withdrawn from consideration

5) ☐ Claim(s) is/are allowed.

6) ☒ Claim(s) 1-20 and 28-32 is/are rejected.

7) ☐ Claim(s) is/are objected to.

8) ☐ Claims are subject to restriction and/or election requirements

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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*Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 1-20 and 28-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Rzeszewski et al (5,699,125).

As to claims 1-5, note the Rzeszewski et al reference which discloses a method and device for receiving and storing electronic program guide data in a receiver having a select channel mode. The select channel feature, as described at col. 4, lines 50+, is one which allows a user, through a remote control, to program a set of select channels, whereby the microprocessor controls the tuning system to skip over non-programmed channels in response to a channel change request, and only stop on the select channels. Thus, when the receiver is in the select channel mode, channel change requests automatically move through the listed and stored channels. The system further requires that only program guide information associated with channels stored by the user in connection with the select channel function be stored, limiting the memory and processing power required for storing the program guide. As to claims, the reference clearly discloses accessing a 'user-definable preferences list' while in the select channel mode, and

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selecting one of the channels and providing the audio and video from the channel source. Further, the reference discloses the retrieval and storage of program guide database information which is broadcast through the system, so as to be accessible by the user. And further, the reference discloses that the retrieval of program guide data and channel selection is performed repeatedly in response to initial and subsequent user requests for select channels. Therefore, all aspects of the claims are met by the reference.

Claims 6-20 are met by that discussed above for claims 1-5.

Further, claims 28-31 are met by that discussed above. That is, the reference clearly discloses that when one is in the 'select channel' mode in which a current channel is in a preference list, subsequent channel changes, whether upward or downward, occur within the context of the mode.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to

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the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rzeszewski et al (5,699,125).

As to claim 32, the reference does not disclose a user identification for accessing one of plural preference lists. However, this is not considered to be a patentable distinction. That is, it was notoriously well-known in the art at the time of the invention to provide pin or password protected preference list(s) to users in the electronic interface environment for television systems. Such a configuration allows access to channel favorites by plural family members, for example, and thus eliminates less user-definable, receiver-based preference models. Therefore, it is submitted that it would have been clearly obvious to one of ordinary skill in the art at the time of the invention to modify the reference with this feature for the stated advantage.

***Election/Restriction***

5. Newly submitted claims 21-27 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

I. Claims 1-20 and 28-32, are drawn to a method for selecting a channel via a preferences list, classified in class 725, subclass 46.

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II. Claims 21-27, are drawn to a preferences list, classified in class 725, subclass 48.

6. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the channel selection method does not require *source* identifiers. The subcombination has separate utility such as in systems with gather channel data at the receiver-side from combinations of satellite, cable, *and* broadcast television networks.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

8. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

9. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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10. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 21-27 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

*Response to Arguments*

11. Applicant's arguments filed 8/30/2001 have been fully considered but they are not persuasive.

Applicant argues that Rzeszewski et al fail to disclose 'a plurality of channels from a plurality of different sources', with respect to a user-definable preferences list. However, the disclosed video distribution system, whether a satellite, a cable, or a broadcast television system, clearly allows the user to define a 'select channel' list and access channels in the list---channels which, by their very nature, stem from different broadcast sources.

*Conclusion*

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

### **Certificate of Mailing**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Assistant Commissioner for Patents  
Washington, D.C. 20231

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### **Certificate of Transmission**



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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

14. Any response to this final action should be:

(a) mailed to: Box AF

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(b) or faxed to: (703) 872-9314 for either formal communications (please mark "EXPEDITED PROCEDURE"), or informal or draft communications (please label "PROPOSED" or "DRAFT")

(c) or hand-delivered to: Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor  
(Receptionist).

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John W. Miller whose telephone number is (703) 305-4795. The examiner can normally be reached on Monday through Friday from 8:30 AM to 6:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile, can be reached at (703) 305-4380. The fax phone number for this Group is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

John W. Miller

November 16, 2001

  
John W. Miller  
Primary Examiner  
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